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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,684	03/30/2004	Hermann Wurm	85934.000035	4016

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EXAMINER

DEUBLE, MARK A

ART UNIT	PAPER NUMBER
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3651

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/812,684

Applicant(s)

WURM, HERMANN

Examiner

Mark A. Deuble

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/24/2004</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the dovetailed groove of claim 6 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitation "the deck" in line 5. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouche (U.S. Patent No. 5,687,858) in view of Bradbury (U.S. Patent No. 4,372,435).

Bouche shows a storage rack 1 that has a plurality of stacked and spaced tote supports 22 arranged in pairs on opposing sidewalls for supporting platform type totes. A storage and retrieval means for moving the totes into and out of bays in the storage racking is provided by a byway 2 that has a deck 5 with rollers 4 protruding therefrom for shifting the totes into and out of the rack. Thus Bouche shows all the structure required by the claims except for the noise deadening insert in the tread of the rollers. However, Bradbury teaches that the outer circumference of a roller body 20 may have an annular groove 32 formed around the circumference thereof to receive an annular elastomeric insert 30 to ensure smoother conveying of articles over the roller body. The insert may be circular in cross section and fit within a dovetailed groove as illustrated in Fig. 4. The elastomeric insert inherently has noise deadening

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properties. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the rollers of Bouche with grooves and elastomeric inserts of the type shown in Fig. 4 of Bradbury to ensure smooth movement of the totes into and out of the storage rack. When this is done, the resulting apparatus would have all the structure required by claims 1-6.

In regard to the limitation of claim 2 that the groove is machined into the tread of the rollers, it should be noted that the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113. Therefore, even though it is unclear how the groove 32 in Bradbury is formed, it still shows all the structure required by the claim.

In regard to the limitation of claim 6 that the groove be dovetailed, it should be noted that the groove shown in Fig. 4 extends around more than half the circumference of the insert so that its upper edges are closer together than the widest part of the groove. Thus it may be said that the groove is dovetailed when the term is given its broadest reasonable interpretation.

7. Claims 1-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouche (U.S. Patent No. 5,687,858) in view of Merbler (U.S. Patent No. 3,895,844).

Bouche shows a storage rack 1 that has a plurality of stacked and spaced tote supports 22 arranged in pairs on opposing sidewalls for supporting platform type totes. A storage and retrieval means for moving the totes into and out of bays in the storage racking is provided by a byway 2 that has a deck 5 with rollers 4 protruding therefrom for shifting the totes into and out of the rack. Thus Bouche shows all the structure required by the claims except for the noise

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deadening insert in the tread of the rollers. However, Merbler teaches that the outer circumference of a polyamide roller body 26 (col. 4, ln. 36) may have an annular groove formed around the circumference thereof to receive an annular elastomeric insert 30 to ensure quieter operation of the roller and to facilitate manufacturing of the hub. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the rollers of Bouche with grooved polyamide hubs and elastomeric inserts of the type shown by Merbler to ensure quiet movement of the totes into and out of the storage rack. When this is done, the resulting apparatus would have all the structure required by claims 1-4, and 7.

In regard to the limitation of claim 2 that the groove is machined into the tread of the rollers, it should be noted that the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113. Therefore, even though it is unclear how the groove in Merbler is formed, it still shows all the structure required by the claim.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art not discussed above shows a variety of roller configurations similar to that of the present invention including rollers having dovetailed joints for attaching an annular elastomeric insert, rollers formed of polyamide, and rollers with noise reducing properties.


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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Deuble whose telephone number is (703) 305-9734. The examiner can normally be reached on Monday through Friday except for alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D Lillis can be reached on (703)308-3248. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

md



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